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OFFICE OF PETITIONS

In re Patent No. 5,587,789
Issue Date: December 24, 1996
Application No. 08/227,281
Filed: April 13, 1994
Patentee: Lee, et al.

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DECISION ON PETITION

This is a decision on the Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)), filed June 30, 2003.

The petition under 37 CFR 1.378(b) is **DISMISSED**.

Background:

The above-identified patent issued December 24, 1996. Accordingly, the first maintenance fee could have been paid during the period from December 24, 1999 through June 24, 2000 without surcharge, or with a surcharge of \$65 during the period from June 25, 2000 through December 24, 2000. The patent expired on December 25, 2000.

A summary of the facts set forth by Petitioner LG Electronics (LG) follows. In early 1997, LG undertook a transfer of the responsibility to pay maintenance fees on its patents from individual law firms to one company - MARKPRO. Through an extensive process in which numerous correspondence was exchanged between the various law firms, LG Headquarters, LG's technical divisions, and MARKPRO, a list of LG's patents was compiled. On March 29, 1997, MARKPRO sent to LG Headquarters an updated final list of approximately 1,500 patents for which MARKPRO would takeover responsibility for maintenance fee payments. LG Headquarters then sent this list to its technical divisions with instructions to check for revisions, additions, or deletions. Any changes to the list were to be returned to LG Headquarters by April 15, 1997.

However, LG did not receive the above patent until April 16, 1997, one day after the final revised list of patents was due back from LG's technical visions to LG Headquarters. Therefore, petitioner states that the above patent was never reported to MARKPRO, so MARKPRO did not know about the patent and did not pay the maintenance fee.

Petitioner has filed the instant petition, asserting that the failure to timely pay the maintenance fee in the above patent was unavoidable.

Law and Analysis:

37 CFR 1.378(b) provides that:

Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

(1) The required maintenance fee set forth in 37 CFR 1.20(e) through (g) (currently \$1,575);

(2) The surcharge set forth in 37 CFR 1.20(I) (1) (currently \$700); and

(3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The instant petition does not meet requirement (3) above.

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 USC 133. **This is a very stringent standard.** Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

Petitioner has not met his burden of establishing that the delay was unavoidable. Petitioner has not established that any steps were taken to pay the maintenance fee in the above patent after

receiving the patent on April 16, 1997. Could MARKPRO not have been contacted **after** April 16, 1997 with instructions to pay the maintenance fee for one more patent? If that was not possible, why did LG not find some other means to pay the maintenance fee?

Conclusion:

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$130 petition fee set forth in \$1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that petitioner supply **any** and **all** relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them.

If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then the maintenance fee and the surcharge set forth in \$1.20(i) are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section, Commissioner for Patents, Washington DC 20231. A copy of the last decision rendered should accompany the request for refund.

Further correspondence should be addressed as follows:

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Telephone inquiries specific to this decision may be directed to the undersigned at (703) 305-0272.



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